

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON  
AT TACOMA

LEWIS JONES and SHARON JONES and  
their marital property,

Plaintiffs,

v.

CLARENCE L. HANKINS, a single man,

Defendant.

CASE NO. C05-5533RJB

ORDER DENYING  
DEFENDANT HANKIN'S [SIC]  
MOTION FOR SUMMARY  
JUDGMENT

This matter comes before the Court on Defendant Hankin's [sic] Motion for Summary Judgment (Dkt. 8). The Court has considered the pleadings filed in support of and in opposition to the motion and the file herein.

**I. FACTUAL AND PROCEDURAL BACKGROUND**

On August 11, 2005, plaintiffs Lewis and Sharon Jones filed a complaint alleging that the defendant, Clarence Hankins, failed to join Mr. Jones as a joint inventor of the invention described in U.S. Patent 6,647,970 B2. The complaint urges the court to correct the patent under 35 U.S.C. § 256 and hold that Mr. Hankins holds benefits received from the patent on constructive trust for the plaintiffs. Dkt. 1 at 3-4. Mr. Hankins counterclaims, contending that the plaintiffs have clouded his title to U.S. Patent 6,647,970 B2. Dkt. 5 at 3.

Mr. Jones and Mr. Hankins (the parties) met while working for a truck manufacturing company. Dkt. 1. In 1979, they began to work on inventing a device for turbocharged diesel engines that would reduce pollution and save fuel. Dkt. 10 at 1, Dkt. 8 at 1. The parties filed for a

1 patent in 1981, and the patent identified both parties as joint inventors. Dkt. 12 at 9. The  
2 application was denied. Dkt. 11, Exh. C at 29. It appears that the parties mutually terminated the  
3 venture due to lack of funding until 1995, when they formed a corporation for the purpose of  
4 selling the device to a Japanese inventor. Dkt. 8 at 2. The sale was never completed, and Mr.  
5 Hankins contends that the parties “abandoned the vapor fuel device and never did any further  
6 work on its development.” *Id.*

7 In 1999, Mr. Hankins began work on a diesel engine device for reducing fuel usage and  
8 pollution. Dkt. 8 at 2. He applied for a patent for this device in 2001, naming himself as the sole  
9 inventor. *Id.* The patent was issued in 2003. *Id.*

10 Mr. Hankins first contends that Mr. Jones played no role in the invention of the second  
11 device because the patent claims are different and because the second device does not involve  
12 vapor fuel. Dkt. 8 at 4. He also alleges that Mr. Jones has abandoned the invention by failing to  
13 work on the device after the sale fell through in 1995. *Id.* at 5.

14 Mr. Jones maintains that he is a joint inventor of both devices because they both include a  
15 double wall reactor, an idea attributable to his efforts. Dkt. 10 at 5. He contends that the double  
16 wall reactor constitutes a substantial contribution that disposes of the issue, regardless of whether  
17 the two devices are substantially similar. *Id.* at 6.

## 18 **II. DISCUSSION**

### 19 **A. SUMMARY JUDGMENT STANDARD**

20 Summary judgment is proper only if the pleadings, depositions, answers to interrogatories,  
21 and admissions on file, together with the affidavits, if any, show that there is no genuine issue as  
22 to any material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ.  
23 P. 56(c). The moving party is entitled to judgment as a matter of law when the nonmoving party  
24 fails to make a sufficient showing on an essential element of a claim in the case on which the  
25 nonmoving party has the burden of proof. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1985).  
26 There is no genuine issue of fact for trial where the record, taken as a whole, could not lead a  
27 rational trier of fact to find for the non moving party. *Matsushita Elec. Indus. Co. v. Zenith Radio*  
28 *Corp.*, 475 U.S. 574, 586 (1986) (nonmoving party must present specific, significant probative

evidence, not simply “some metaphysical doubt.”). *See also* Fed. R. Civ. P. 56(e). Conversely, a genuine dispute over a material fact exists if there is sufficient evidence supporting the claimed factual dispute, requiring a judge or jury to resolve the differing versions of the truth. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 253 (1986); *T.W. Elec. Serv., Inc. v. Pac. Elec. Contractors Ass’n*, 809 F.2d 626, 630 (9th Cir. 1987).

The determination of the existence of a material fact is often a close question. The court must consider the substantive evidentiary burden that the nonmoving party must meet at trial – e.g., a preponderance of the evidence in most civil cases. *Anderson*, 477 U.S. at 254; *T.W. Elec. Serv., Inc.*, 809 F.2d at 630. The court must resolve any factual issues of controversy in favor of the nonmoving party only when the facts specifically attested by that party contradict facts specifically attested by the moving party. The nonmoving party may not merely state that it will discredit the moving party’s evidence at trial, in the hopes that evidence can be developed at trial to support the claim. *T.W. Elec. Serv., Inc.*, 809 F.2d at 630 (relying on *Anderson, supra*). Conclusory, non specific statements in affidavits are not sufficient, and missing facts will not be presumed. *Lujan v. Nat’l Wildlife Fed’n*, 497 U.S. 871, 888-89 (1990).

## **B. JOINT INVENTOR STATUS**

35 U.S.C. § 256 creates a cause of action in district court for correction of non-joinder of a joint inventor on a patent so long as there was no deceptive intent. 35 U.S.C. § 256. There is a presumption that the inventors are named correctly in the patent. *Hess v. Advanced Cardiovascular Sys., Inc.*, 106 F.3d 976, 980 (Fed. Cir. 1997). A plaintiff alleging misjoinder therefore bears a heavy burden of proving its case by clear and convincing evidence. *Id.* The plaintiff may not rely merely upon her own testimony to establish her contribution to the invention but must instead offer corroborating evidence. *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456, 1461 (Fed. Cir.1998). Corroborating evidence may include contemporaneous documents created by the alleged joint inventor, circumstantial evidence about the invention process, and oral testimony of other witnesses. *Id.*

Joint inventorship under 35 U.S.C. § 116 contemplates collaboration, though the parties need not physically work together at the same time. 35 U.S.C. § 116(1). The statute’s use of the

word “jointly” is not mere surplusage. *Kimberly-Clark Corp. v. Procter & Gamble Distrib. Co.*, 973 F.2d 911, 917 (Fed. Cir. 1992). Some element of joint behavior is required, and individuals working independent from and ignorant of the other’s efforts are not joint inventors. *Id.* Here, it is undisputed that the parties worked in concert on a fuel saving and pollution reducing device for diesel trucks at least until 1995. The only question remaining is whether there is a genuine issue of material fact as to whether Mr. Jones’s contributions were sufficient to confer joint inventor status.

The alleged joint inventor’s contribution need not equal the contributions of the listed inventor. 35 U.S.C. § 116. Moreover, the plaintiff in a suit for misjoinder need not demonstrate that she contributed to every claim in the patent. *Id.* (“Inventors may apply for a patent jointly even though . . . each did not make a contribution to the subject matter of every claim of the patent.”). There is no minimum contribution required for a person to qualify as a joint inventor so long as she contributes to the conception of the invention. *Fina Oil & Chem. Co. v. Ewen*, 123 F.3d 1466, 1473 (Fed. Cir. 1997). The contribution to the conception of the invention must not be “insignificant in quality, when . . . measured against the dimension of the full invention.” *Id.* Mere explanation of the state of the art, contribution removed from the real-world realization of an invention, and assistance after conception are insufficient. *Hess*, 106 F.3d at 981; *Eli Lilly and Co. v. Aradigm Corp.*, 376 F.3d 1352, 1359 (Fed. Cir. 2004); *Ethicon*, 135 F.3d at 1460.

Mr. Hankins urges the court to hold that Mr. Jones cannot be considered a joint inventor of the second device because the claims of the two patent applications differ. Dkt. 8-1 at 3-4. Mr. Jones contends that regardless of whether the two devices are similar, his contribution of a double walled reactor was significant and that the second device could not function without this contribution. Dkt. 10 at 5, Dkt. 12 at 5-6. Mr. Hankins’s reply fails to rebut Mr. Jones’s contention about the nature and significance of his contribution. *See* Dkt. 13. The motion for summary judgment on this ground should therefore be denied.

### C. ABANDONMENT

35 U.S.C. § 102 provides, “A person **shall be entitled to a patent** unless . . . he has

1 abandoned the invention.” 35 U.S.C. § 102 (emphasis added). Actual abandonment occurs when  
2 the inventor affirmatively conceals the invention from the public so that he may use it indefinitely  
3 and exclusively for his own profit. *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1567 (Fed. Cir. 1996).  
4 Abandonment may also be inferred from an inventor’s unreasonable delay in disclosing the  
5 invention to the public. *Dow Chem. Co. v. Astro-Valcour, Inc.*, 267 F.3d 1334, 1342 (Fed. Cir.  
6 2001).

7 Mr. Hankins contends that he is entitled to summary judgment because he and Mr. Jones  
8 abandoned the invention in 1995 and because Mr. Jones fails to address this claim in his response  
9 brief. Dkt. 8-1 at 5; Dkt. 13. Section 102(c) explicitly applies to the issuance of patents. Mr.  
10 Hankins’s motion and reply offer no legal authority for the notion that a suit to correct misjoinder  
11 under 35 U.S.C. § 256 may be barred by the joint inventor’s abandonment of the invention and no  
12 argument that the concept should apply by analogy to joint inventor contributions. The motion  
13 should therefore be denied.

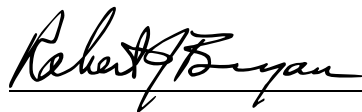
### 14 III. ORDER

15 Therefore, it is hereby

16  
17 **ORDERED** that Defendant Hankin’s [sic] Motion for Summary Judgment (Dkt. 8) is  
18 **DENIED.**

19 The Clerk of the Court is instructed to send uncertified copies of this Order to all counsel  
20 of record and to any party appearing *pro se* at said party’s last known address.

21 DATED this 16<sup>th</sup> day of August, 2006.

22  
23   
24 Robert J. Bryan  
25 United States District Judge  
26  
27  
28